



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097001,240	12/30/97	BASHAN	CUHN14702

HELFGOTT AND KARAS
60TH FLOOR
EMPIRE STATE BUILDING
NEW YORK NY 10118-6098

MM32/0625

EXAMINER
LE, T

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 06/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/001,240

Applicant(s)
Bashan et al.

Examiner
Thien Le

Group Art Unit
2876



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2,4
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The priority paper filed on 5/29/98 and the information disclosure statements filed on 5/26/98 and 6/24/98 have been entered. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kreft [5,773,812].

Regarding claim 1, Kreft discloses a chip card comprising a chip 1, electrical contacts 2, and coil windings 5 for contactless communication. As can be seen, Kreft discloses the claimed invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreft [5,773,812].

Regarding claim 2, see the discussions regarding claim 1. The claim differs in calling for a separate I/O ports for contactless and contact communication. It would have been obvious to incorporate separate I/O for the modes. The modification is merely a design consideration which is well within the skill levels and expectation of an ordinary skilled artisan which is not considered novel.

Regarding claims 3 and 8, see the discussions regarding claims 1-2. The claim differs in calling for a voltage for selecting the mode of operation. It would have been obvious to replace Kreft's switch with an automatic mode switching means. The modification is merely an engineering design consideration which is used to increase user's convenience.

Regarding claim 4, the claimed feature is a typical functions and elements of a contactless card which is inherent in light of Kreft's teaching.

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Regarding claim 5, see the summary of the Kreft reference.

Regarding claim 6, see col. 2-7 of Kreft.

Regarding claim 7, see the discussions regarding claims 3 and 4.

Regarding claims 9-27, see the discussions regarding claim 1-8. The claims differ in calling for specification modulation scheme, transmission protocol, coding, etc. Official Notice is taken of the use of the specification modulation scheme, coding, transmission protocol, etc. as recited in the claims in known data transmission systems. Without any unexpected result, the modification are merely engineering design consideration which is well within the skill levels and expectation of an ordinary skilled artisan; and thus is not considered novel.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday to Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, and 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Thien Le
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June 20, 1999